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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,659	10/26/2001	Glen B. Cook	SP01-302	4629
22928	7590	12/09/2005	EXAMINER	
CORNING INCORPORATED			HOFFMANN, JOHN M	
SP-TI-3-1			ART UNIT	
CORNING, NY 14831			PAPER NUMBER	
			1731	
DATE MAILED: 12/09/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/035,659

Applicant(s)

COOK ET AL.

Examiner

John Hoffmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims require calls for sacrificial preform sections. To one of ordinary skill this suggests that the sacrificial preform section is sacrificed (thrown away) – however the last line of the claim also requires that the optical fiber is made from the sacrificial preform sections – which suggests it is NOT sacrificed. Examiner then looked to the specification to see if there was any definition for “sacrificial preform section” and could not find any.

See Allen Eng'g Corp. V. Bartell Indus. Inc. 299 F.3d 1336, 1348, 63 USPQ2d 1769, 1775 (Fed. Cir. 2002) (quoting Personalized Media Communications, LLC v. Int'l Trade Comm'n, 161 F.3d 696, 705, 48 USPQ2d 1880, 1888 (Fed. Cir. 1998)) (“In determining whether the claim is sufficiently definite, we must analyze whether “one skilled in the art would understand the bounds of the claim when read in light of the specification.”) See also, Exxon Research & Eng'g Co. v. United States, 265 F.3d 1371, 1375, 60 USPQ2d 1272, 1276 (Fed. Cir. 2001) (citation omitted) (patent claims must be “sufficiently precise to permit a potential competitor to determine whether or not he is infringing”).

For the reasons given above, a potential competitor would not be able to tell whether any particular perform is or is not a sacrificial preform and thus could not determine whether or not he is infringing.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeNoane 4407667 (or Sterling 4195980) in view of Gwo 6284085. . (Note: other references are used as evidence as to what is inherent)

LeNoane (as well as Sterling) discloses the bonding of glass preforms, but not the temperature limitation. Gwo teaches that one can create a strong room-temperature bond in a manner which is simple and inexpensive. IT would have been obvious to change the LeNoane (or the Sterling) process, by using the improved bonding procedure of Gwo, for the advantages of Gwo. Relevant portions of Gwo include the abstract, col. 1, lines 22-29; from col. 1, line 61 to col. 2, line 19; col. 3, lines 37-62; col. 6, lines 42-62.

As to the flatness limitation of 5 microns (which is not taught in LeNoane or Sterling) : See Gwo, col. 7, lines 12-15, especially col. 6, lines 24-41 which discloses microroughness, and filling sub-micro-meter gaps. Col. 5, lines 16-19 discloses that one doesn't have to use a silicate if the mismatch is small. Also, col. 5, line 14 refers to

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“precision bonding”. It would have been obvious to have the surfaces as flat as possible so as to avoid the need for adding a silicate and to most precisely bond the objects.

As to the sacrificial preform sections. First it is noted that Examiner could not find a definition for “sacrificial preform section”. It is deemed that sacrifice is an intended use limitation that does not define over the LeNoane or Sterling methods. For example, one can designate that every even numbered preform is a regular fiber preform, and every odd numbered preform is a sacrificial preform. More importantly, claim 22 requires drawing the optical fiber from the sacrificial preform. Clearly since Applicant’s ‘method of forming an optical fiber’ requires drawing a fiber from a sacrificial preform, one can draw a fiber from the LeNoane or Sterling sacrificial preform.

Furthermore, one could consider the “sections” to parts of the lower preforms. For example, each preform would have an upper section and a lower section. There is nothing that prohibits the preform section to be integrally connected with another preform, such that they are both in the form which is a single preform.

As to the sacrificial preform being “lower” - LeNoane clearly has this. As to Sterling – it would have been obvious to draw the fiber downward – Applicant admits in the “Background” portion of the specification that this is typically how it is done. Examiner also takes Official notice that fibers are typically drawn downward – the theoretical basis therefore: for gravity assist, (especially during the initial gob drop to start the fiber draw). Also, gravity is uniform circumferentially when drawn downward but not when done horizontally.

Claims 23-31 are met for the reasons given in the prior Office action.

Response to Arguments

Applicant's arguments filed 11 October 2005 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Therefore, it does not much matter that Gwo does not teach bonding fiber preforms: the combination as a whole provides for such. Applicant has not indicated why Gwo's lack is relevant in view of the fact that the other references disclose this feature that Gwo lacks.

It is argued that the sacrificial preform sections are shorter than a regular preform. This is an assertion with no evidence or rationale to support this. In the event that applicant is implying that the figures show the size difference: (1) Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). (2) There is no indication that the drawings are made to scale.

The specification must clearly set forth the definition explicitly and with reasonable clarity, deliberateness and precision. *Teleflex Inc. v. Ficosa North America Corp.*, 63 USPQ2d 1374, 1381 (fed. Cir. 2002), *Rexnord Corp. v. Laitram Corp.* 60 USPQ2d 1851, 1854 (fed. Cir. 2001) and MPEP 2111.01.

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Applicant cannot now create a definition for "sacrificial preform section"

Furthermore, even if the claims require a specific size: a difference in size is generally not a patentable distinction:

From MPEP 2144.04

A. Changes in Size/Proportion

In re Rose , 220 F.2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art.); In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.).

In Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

The claims do not require a step of sacrificing.

AS pointed out before:

The term "sacrificial" is deemed to be just an intended use – and does not affect the structure. Examiner could not find any definition for "sacrificial preform" that signifies anything other than intended use. Nor has applicant pointed out any definition. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably

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distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Presently, the prior art preforms are deemed capable of performing the intended sacrificial use – thus they meet the claim.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

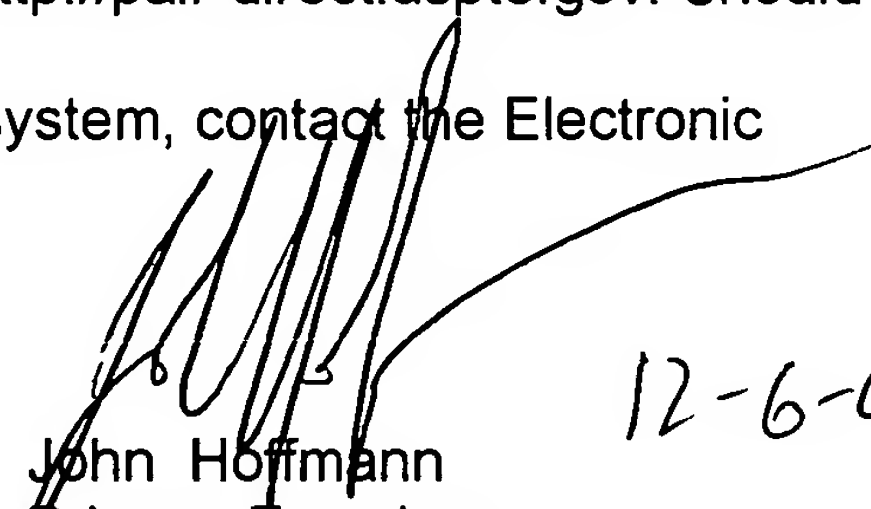
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John Hoffmann
Primary Examiner
Art Unit 1731

12-6-05

jmh